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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/579,149

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Mario Huesca

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12/08/2008

Ballard Spahr Andrews & Ingersoll, LLP
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EXAMINER

KLINKEL, KORTNEY L

ART UNIT

PAPER NUMBER

1611

MAIL DATE

DELIVERY MODE

12/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/579,149	Applicant(s) HUESCA ET AL.	
	Examiner Kortney L. Klinkel	Art Unit 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-39 is/are pending in the application.
- 4a) Of the above claim(s) 23, and 28-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 21, 22, 24-27 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/17/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims

Receipt is acknowledged of remarks filed 8/14/2008.

Claims 1-20 were cancelled.

Claims 26 and 37 were amended.

Claim 39 was added.

Claims 21-39 are pending in the instant Office action.

Election/Restriction

Applicant's election with traverse of group XVI, which is drawn to a compound of formula I wherein R2 and R3 form a polycyclic ring system that contains the phenanthroline functional group and R1 is indole in the reply filed on 8/14/2008 is acknowledged. Group XVI encompasses currently amended claims 21-27 and 39. Acknowledgement is also made of applicants' election of compound 90, page 38 of the specification, also the compound of instant claim 39 with traverse. Claims 21-22, 24-27 and 39 read on the elected species.

The traversal is on the ground(s) that in light of the current claim amendments, the claims have unity of invention, and share the same special technical feature which allegedly makes a contribution over the prior art as the Mjalli reference originally used to break the unity no longer teaches the special technical feature of the current claims. Applicant also argues sections from MPEP chapter 800 pertaining to search burden.

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These arguments are not found persuasive because, the inventions as currently amended, which are listed as Groups XVI, XVII and XXIX from the restriction requirement dated 6/17/2008 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features. The special technical feature linking the current claims is a compound of formula VI. This element cannot be a special technical feature under PCT Rule 13.2 because the element is shown in the prior art. In the present case, Bannister et al. (WO 2000/78761) teaches compounds of generic formula VI (see page 18). As a result, no special technical features exist among the claims because the inventions fail to make a contribution over the prior art.

Furthermore, the establishment of burden on the Office applies to US cases only. The instant application is a national stage entry of an international application under 35 U.S.C. 371. As a result, lack of unity practice is observed for restriction purposes.

Because Applicant amended their claims around the art originally used to break the unity, the requirement is still deemed proper and is therefore made FINAL.

Claims 23 and 28-38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected subject matter, there being no allowable generic or linking claim. Election was made with traverse in the reply filed on August 14, 2008.

Claims 21-22, 24-27 and 39 are currently under consideration to the extent that they read on the elected species, namely the compound of claim 39. Please note also

that examination of all 112 1st issues such as enablement and written description, of the claims have been limited to the elected species only.

Priority

Acknowledgement is made that the instant application is a 371 of PCT/IB04/52433 filed 11/15/2004, which claims benefit of 60/520279 filed 11/14/2003 and claims benefit of 60/599509 filed 8/6/2004. Note is made that the elected species, compound 90, page 38 of the specification, also the compound of instant claim 39, has support back to the earliest filed provisional application, 60/520279 filed 11/14/2003.

Information Disclosure Statement

Acknowledgement is made of applicant's submitting an information disclosure statement on November 17, 2006. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

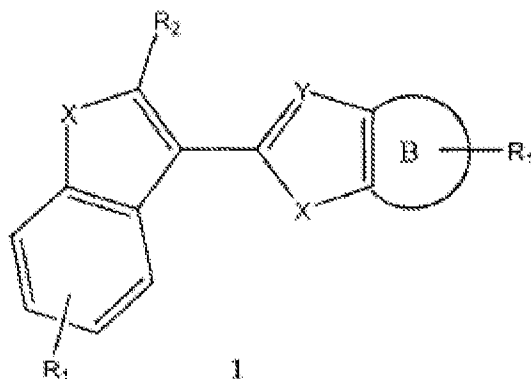
The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 21-22, 24-27 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bannister et al. (WO 2000/78761).

Bannister teaches compounds of the following general formula.



Wherein X can be NH, Y can be N, R₂ can be Me, R₁ need not be present and B can be a polycyclic cycloalkyl or heteroaryl, or heterocyclic rings *inter alia* (page 18, also claims 1-20). Pages 10-11 of the disclosure further define the term heterocyclyl or heterocyclic group to mean phenanthroline.

Bannister teaches several examples wherein R₂ is Me, X is NH, Y is N and R₁ is absent. Bannister fails to teach a specific embodiment wherein B is phenanthroline. However, phenanthroline is suggested as a possible B ring from a finite number of possible combinations. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the instant invention, to arrive at the elected species with a reasonable expectation for success. One would have been motivated to do so because the elected compound is suggested from a finite number of possible combinations.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21-22, 24-27 and 39 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 25 and 42 of copending Application No. 10/525690. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are drawn to a compound of formula VI and the co-pending claims of application '690 are also drawn to a compound of formula VI. The definitions of substituents of these two formulae overlap significantly and only vary in a few instances (i.e. the instant R6 is slightly more limited than R6 of co-pending '690). Claims 25 and 42 generically encompass the elected species of the instant application. It would be obvious to arrive at the elected species, as it is suggested from a finite listing of possible combinations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 21-22, 24-27 and 39 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-55 of copending Application No. 11/915257. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are drawn to a compound of formula VI and the co-pending claims of application '257 are drawn to compounds of formula I, which have a phenanthroline backbone and are structurally very similar to compounds of instant formula IV. The definitions of substituents of these two formulae overlap significantly and only vary slightly in scope. The claims of application '257 recite various intended uses. However, a recitation of the intended use of a compound must result in a structural difference between the claimed invention, absent this difference, the compounds of application '257 and the instant compounds are indistinguishable. Application '257 teaches the elected species of the instant application. This compound is numbered "3" in application '257.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Claims 21-22, 24-27 and 39 are rejected. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kortney Klinkel whose telephone number is (571)270-5239. The examiner can normally be reached on Monday-Friday 8am to 5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached at (571)272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KLK

/Sharmila Gollamudi Landau/
Supervisory Patent Examiner, Art Unit 1611